

REMARKS/ARGUMENTS

Currently, claims 1-49 are pending. The Examiner rejected one or more claims as being indefinite under 35 U.S.C. § 112, as covering unpatentable subject matter under 35 U.S.C. § 101, and as being anticipated or made obvious by Wong (alone or with other references). Each of the Examiner's rejections is addressed in turn.

Claims 15, 25-26, and 39-46 Have Been Amended To Obviate Rejections under 35 U.S.C. § 112

Claims 15, 25-26, and 39-46 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejected claims have been amended to address the Examiner's rejection.

As Amended, Claims 1-47 Claims Statutory Subject Matter

Claims 1-47 were rejected under 35 U.S.C. § 101 because the claimed invention was directed to non-statutory subject matter.

Claim 1 as amended now clearly recites a practical application for the method. The practical application is to predict a level of consumption of healthcare resources by a plan member. As such, consistent with the Patent Office's Flowchart from the Examination Guidelines for Computer-Related Inventions for determining when a computer-related application meets the requirements of Section 101, since the computer related process is limited to a practical application in the technological arts, the present invention meets Section 101. In particular, predicting a level of consumption of healthcare resources by a plan member is a practical application in a technological art. Since claims 2-47 depend from claim 1, and therefore incorporate the limitations of claim 1, for the reasons set forth above, these claims cover statutory subject matter under Section 101.

Furthermore, Applicants respectfully disagree with the Examiner's basis for rejecting the claims by stating that "all of the recited steps can be performed in the mind of the use or by use of a pencil and paper." See Office Action at 5. The Federal Circuit and the C.C.P.A. have disapproved of the use of this doctrine in contexts similar to this invention as claimed. In the

Application of Benson, 441 F.2d 682, the Court reversed the Patent Office's rejection of a method claim under Section 101 and addressed the inapplicability of this doctrine. See also State Street Bank & Trus Co. v. Signature Financial Group, Inc., 149 F.3d 1368 (Fed. Cir. 1998) (Court reversed a district court holding that a claim covered unpatentable subject matter, where the district court in part relied on a basis similar to that of the Examiner in the present case.).

Wong Does Not Anticipate Or Make Obvious Claims 1-47

The Examiner rejected claims 1-7, 9, 11, 14-16, 18-21, 23-24, 25-32, 35-37, and 39-46 were rejected under 35 U.S.C. § 102(e) as being anticipated by Wong et al. U.S. 5,976,082 ("Wong"). Furthermore, the Examiner rejected the remaining claims as made obvious by Wong, alone or in combination with another reference. As will be discussed, for the following two reasons, Wong does not anticipate or make obvious the present invention as claimed in claims 1-47: (1) Wong does not disclose or suggest "calculating a burden of illness;" and (2) Wong does not disclose or suggest predicting a level of consumption of healthcare resources by a plan member.

First, unlike the present invention as claimed in claim 1, Wong is in the context of a single disease: congestive heart failure. This difference is embodied in the calculation of a "burden of illness," which is not based on a single disease. In Wong, because it is in the context of a single disease, it does not disclose or suggest calculating a burden of illness. The computation in Wong may, in one embodiment, correspond to the analysis of the at least one explanatory variables in claim 1.

Second, claim 1 is a method for predicting consumption of healthcare resources by a plan member. In contrast, Wong relates to identifying at risk congestive heart failure patients. Wong does not disclose or suggest predicting consumption of healthcare resources by a plan member as required by claim 1. As such, the computation in Wong goes to determining at risk congestive heart failure patients not predicting consumption of healthcare resources by a plan member.

For these reasons, Wong does not anticipate or make obvious (alone or in combination with other references relied on by the Examiner) claim 1.

Because the other claims 2-47 depend from claim 1 and as such incorporate the elements of claim 1, for the above reason, claims 2-47 are not anticipated or made obvious.

CONCLUSION

This application, including claims 1-47 and new claims 48 and 49, now stands in allowable form and reconsideration and allowance is respectfully requested.

Respectfully submitted,

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